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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,010

04/13/2004

Michael Lehman

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4682

7590

03/24/2005

Steven W. Webb
Law Offices of Steven W. Webb
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EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,010

Applicant(s)

LEHMAN, MICHAEL

Examiner

R. Alexander Smith

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: *All the numbers disclosed in the specification are not in the drawings.*

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 1-5 are objected to because of the following informalities. Appropriate correction is required.

In claim 1:

a) As written claim 1 appears to be a hybrid claim, however, the separation of the method step in line 14 on page 7 of attaching the mast clip from the method preceding it is not proper.

b) --comprising-- should be inserted before "a flat piece" in line 5 on page 6.

- c) "recangular" in line 6 on page 6 should be --rectangular--.
- d) --being-- should be inserted before "clean" in line 8 on page 6.
- e) --being-- should be inserted before "clean" in line 14 on page 6.
- f) "pealable" starting in line 13 on page 6 and used throughout the claim should be --peelable--. This also applies to the specification.
- g) "a three part adhesive strip" in line 4 on page 7 should start with --the-- in order to properly refer to its antecedent.
- h) "one pealable strip" in line 6 on page 7 should be --one said peelable cover-- in order to be spelled correctly and in order to properly refer to its antecedent.
- i) "pealable strip" in line 10 on page 7 should be --peelable cover-- in order to be spelled correctly and in order to properly refer to its antecedent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4,590,883 to Steed et al. in view of U.S. 5,881,481 to Bashaw, Jr. et al. and U.S. 4,673,153 to Hilty et al.

Steed et al. discloses an attachment system (figures 1 and 2) comprised of a three-part adhesive strip that meet most of the limitations of claim 1 (see column 1, lines 53-63 and the discussion about the extended portion and adhesive applied to one or both areas 3, 4). Furthermore, Steed et al. discloses that the flag is supported by the wider part of the mast below the flag (column 1, lines 64-68).

Steed et al. does not disclose the two outside rectangular sections (3 and 4 of the extended portion) possessing peelable covers that completely cover the contact adhesive, peeling off the adhesive before applying the corresponding outside rectangular section to the edge of the pennant; and a mast clip having means of a bead of tacking adhesive inside, and attaching the mast clip to the mast beneath the pennant in such a manner that the weight of the pennant on the mast is held up by the mast clip and the pennant is prevented from sliding down the mast and the limitations of claims 2-5.

Bashaw, Jr. et al. discloses an attachment system wherein two outer parts of a strip include adhesive peelable covers that are removed prior to use in order to protect the adhesive surface (figure 4 and column 7, lines 24-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system, taught by Steed et al., to include peelable covers that are peeled before applying the outside rectangular sections to the pennant, as taught by Bashaw, Jr. et al., in order to protect the adhesive before use.

Hilty et al. discloses a system for supporting items on a pole wherein the clip is of plastic, that allows sliding along the pole and that is designed to support the weight of an item mounted thereto. Furthermore, Hilty et al. discloses that the clip can be held in an appropriate attitude as an alternative by various attachment means such as by glue (column 4, lines 1-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system, taught by Steed et al., to include a mask clip with a bead of tacking adhesive inside, as suggested by Hilty et al., in order to allow mounting the flag on a mast that is straight and that does not have a wider section below the flag for support.

With respect to claims 2 and 3 and the contact adhesive being strong enough to hold the weight of a paper pennant or a cloth flag: These limitations are only considered to be the "optimum" values of the adhesion strength of the system disclosed by Steed et al. as modified by Hilty et al., as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the maintaining the item being supported at the appropriate attitude on the mast as already taught by Hilty et al. See In re Boesch, 205 USPQ 215 (CCPA 1980).

With respect to claim 4 and the mast clip being of metal: This limitation is only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide to make the clip disclosed by Hilty et al. since they are well known types of materials used to make clips and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention. In re Leshen, 125 USPQ 416.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related systems.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a large, stylized initial 'R' and a long, sweeping horizontal stroke extending to the right.

R. Alexander Smith
Patent Examiner
Technology Center 2800

RAS
March 18, 2005